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In re Application of :  
CHALL :  
Application No.: 10/585,079 : DECISION ON  
PCT No.: PCT/NL2004/000922 :  
Int. Filing Date: 29 December 2004 : PETITION UNDER  
Priority Date: 30 December 2003 :  
Attorney Docket No.: 292853US2PCT : 37 CFR 1.497(d)  
For: METHOD, DEVICE AND DIFFRACTION :  
GRATING FOR SEPARATING SEMICONDUCTOR :  
ELEMENTS FORMED ON A SUBSTRATE BY :  
ALTERING SAID DIFFRACTION GRATING :  
:

This decision is in response to applicants' submission filed in the United States Patent and Trademark Office (USPTO) on 23 July 2007, which has properly been treated as a petition under 37 CFR 1.497(d).

**BACKGROUND**

On 29 December 2004, applicant filed international application PCT/NL2004/000922 which designated the U.S. and claimed a priority date of 30 December 2003. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 14 July 2005. The thirty-month period for paying the basic national fee in the United States expired at midnight on 30 June 2006.

On 29 June 2006, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the Basic National Fee.

On 23 March 2007, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 23 July 2007, applicants filed the instant submission which has properly been treated as a petition under 37 CFR 1.497(d). The petition is accompanied by a statement by Petrus Henrikus Van Der Laak and a declaration.

**DISCUSSION**

37 CFR 1.497(d), provides:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92<sup>bis</sup> subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in Sec. 1.17(i); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see Sec. 3.73(b) of this chapter); and
- (4) Any new oath or declaration required by paragraph (f) of this section.

Items (1) and (2) have been satisfied.

Item (3) has not been satisfied. No mention is made in the petition regarding whether an assignment has been executed. If an assignment has been executed, the written consent of the assignee is required. See MPEP § 324 for a proper showing under 37 CFR 3.73(b).

As to item (4), a new declaration is not required by 37 CFR 1.497(f) in the instant situation.

**CONCLUSION**

The request under 37 CFR 1.497(d) is **DISMISSED** without prejudice for the reasons set forth above.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.497(d)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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